

REMARKS

This application has been reviewed in light of the Office Action dated March 19, 2009. Claims 1-8 and 10-18 are presented for examination, of which Claims 1, 10, and 12 are in independent form. Claims 1, 10, and 12 have been amended. Applicants request favorable reconsideration.

Claims 1-8, 10-14, and 16-18 were rejected under the judicially-created doctrine of obviousness-type double patenting, as being unpatentable over claim 39 of U.S. Patent Application No. 10/071,615 (“the ‘615 application”). The Office Action does not explicitly state whether the rejection are provisional. However, in accordance with the practice under MPEP § 804(I)(B), the rejection should be deemed provisional. Other rejections remain in both the present application and the ‘615 application. Therefore, Applicants need not file a terminal disclaimer in this application pending the provisional double patenting rejection. However, Applicants would be willing to file such disclaimer should the other rejections in this application be withdrawn, leaving a double patenting rejection as the sole outstanding rejection.

Claims 1-8, 10-14, and 16-17 were rejected under 35 U.S.C. § 101, as failing to recite statutory subject matter. In particular, claims 1-8, 10, and 11 were considered to read on software, while claims 12-18 were considered to be directed towards methods not sufficiently tied to a particular machine or apparatus. In response, independent claims 1, 10, and 12 have been amended to further emphasize the patent-eligibility of the subject matter recited by the claims rejected under § 101. Applicants submit that the independent claims, along with the claims depending from them, recite patent-eligible subject matter.

Independent Claim 1 recites a computer-implemented acquisition system comprising, among other elements, a plurality of worker utilities and a plurality of handler

systems. The worker utilities are implemented on at least one computer. Similarly, the handler systems also are implemented on at least one computer. Thus, the system of claim 1 includes two components comprising at least one computer, which in the language of § 101 may be described as a machine or manufacture. Accordingly, claim 1 and the claims depending from it recite patent-eligible subject matter.

Independent Claim 10 recites a computer-implemented acquisition system comprising in part elements similar to those discussed with respect to claim 1. Therefore, the reasoning underlying the patent-eligibility of claim 1 is applicable here. Accordingly, claim 10 and the claim depending from it also recite patent-eligible subject matter.

Independent Claim 12 recites a computer-implemented acquisition method. In one step, a dispatcher determines a corresponding one of a plurality of handler systems to which to route application data. In another step, the dispatcher routes the application data to the determined handler system. The handler system is configured to invoke at least one of a plurality of worker utilities. In still another step, at least one of the plurality of worker utilities is invoked to perform tasks to, among other things, validate the application data. The plurality of handler systems are implemented on at least one computer, and the plurality of worker utilities are implemented on at least one computer.

Claim 12 recites a “process” within the meaning of § 101. When a method is either tied to a particular machine or apparatus, or transforms a particular article into a different state or thing, that method is eligible for patenting. *See In re Bilski*, 545 F.3d 943, 954 (discussing the “machine-or-transformation test” and its application). Here, the method of claim 12 satisfies at least the machine prong of the machine-or-transformation test. The method includes steps performed by handler systems and worker utilities, both of which are implemented

on computers. Accordingly, the method is tied to the positively-recited computers. Furthermore, these computers are integral to the method, and the manner in which they are used is well-defined. Thus, their recitations impose a meaningful limit on the scope of the acquisition method. For these reasons, Applicants submit that claim 12 and the claims depending from it are patent-eligible.

Claims 1-8, 10-14, and 16-18 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. These claims also were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

In rejecting claims under § 112, first paragraph, the Office has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in the disclosure a description of the invention defined in the claims. MPEP § 2163(III)(A). To satisfy this burden, express findings of fact must be made. *Id.* These findings should both identify the claim limitations at issue and provide reasons as to why a person skilled in the art would not recognize the inventor's possession of the claimed invention. *Id.*

Applicants traverse the rejection under § 112, first paragraph, on the ground that the Office has not established a *prima facie* case of failure to comply with the written description requirement. The rejection is deficient in several ways. No express findings of fact are made. The rejection merely states the conclusion that the one skilled in the art would not recognize Applicants' possession of the claimed invention. There is no reasoning given for this conclusion. The rejection also fails to identify which claim limitations are at issue. For these reasons, Applicants submit that no *prima facie* case has been made of Applicants' failure to comply with § 112, first paragraph.

Assuming *arguendo* that the rejection under § 112, first paragraph, is proper, Applicants respectfully submit that the claims comply with the written description requirement. As to claim 1, that claim recites an acquisition system comprising four elements: a portal, a plurality of worker utilities, a plurality of handler systems, and a dispatcher. Applicants' specification at paragraph [0019] and their drawings provide adequate support for claims to these elements. The specification further supports the configurations of these elements recited in claim 1. The portal is configured to receive application data associated with an application for a product or service. This feature is disclosed at, for example, paragraphs [0019] and [0024]. The plurality of worker utilities are configured to process a plurality of applications. This feature is disclosed at, for example, paragraphs [0019] and [0026]. The plurality of handler systems is configured to invoke at least one of the plurality of worker utilities, and each of the handler systems is associated with a product or service. These features are disclosed at, for example, paragraphs [0019], [0025], and [0026]. The dispatcher is configured to receive application data from the portal and route it to one of the handler systems based on the product or service associated with the received application data. These features are disclosed at, for example, paragraphs [0019] and [0025]. Therefore, independent claim 1 is adequately supported by the originally-filed disclosure. Accordingly, Applicants submit that one skilled in the art would reasonably conclude that Applicants had possession of the acquisition system recited in claim 1.

Because independent claims 10 and 12 recite features similar to claim 1, Applicants also submit that these claims also are adequately supported by the originally-filed disclosure. Applicants further submit that each of the dependent claims is adequately supported by the disclosure in the specification associated with Figs. 1-3.

Turning to the rejection under § 112, second paragraph, Applicants have carefully reviewed the rejected claims to ensure that they conform fully to the requirements of § 112, second paragraph, with special attention to the points raised at page 3 of the Office Action. Applicants believe that these claims, as previously examined, conform fully to the requirements of § 112, second paragraph. Accordingly, they traverse this rejection for the following reasons.

The Office Action considers vague and indefinite the underlying structure of the worker utilities and the handler systems. Initially, Applicants note that diagrams of example systems showing the structural relationship between these features are shown in Figs. 1-3. What comprises the underlying structure of a worker utility or a handler system is discussed in paragraph [0018]. Specifically, a worker utility or handler system may be comprised of hardware components, such as integrated circuit components, and/or software components. Moreover, as now recited in the claim 1, these features are implemented by a computer. Therefore, Applicants submit that they have sufficiently described to one of ordinary skill in the art both the structure of a worker utility and a handler system, as these components are recited in claim 1, as well as how they are configured in an acquisition system as a whole.

The Office Action further considers vague and indefinite the steps or algorithms performed by a worker utility and a handler system. Such steps or algorithms are discussed throughout the specification, with particular examples discussed at paragraphs [0023] and [0025]-[0027]. In the acquisition system recited in claim 1, the worker utilities are configured to process a plurality of applications received by the system's portal. Each application is associated with a corresponding product or service. However, as discussed at paragraph [0026], each worker utility is discrete unit that can perform a particular task, and may only have a limited number of functions. While the worker utilities collectively can process the applications

received by the portal, each one may not have the capabilities to do so. Thus, as described at paragraph [0025], the system can use handler systems (in conjunction with a dispatcher) to facilitate the processing of applications by the worker utilities. Each handler system is associated with a corresponding product or service. In operation, after receipt by the portal, an application can be routed by the dispatcher to the handler system associated with that application's corresponding product or service. The handler system invokes at least one of the worker utilities to process the application. (On this point, Applicants note that the handler system does not itself process an application. Rather, it invokes the worker utilities to process the application.) The invoked worker utilities perform the discrete tasks necessary to process the application. Applicants submit that the components, as recited in claim 1, are described in a manner consistent with the clear description of these components set forth in the specification. Thus, claim 1 is rendered neither vague nor indefinite to one of ordinary skill in the art.

The Office Action posits two questions with regard to the claims rejected under § 112, second paragraph. First is asked what it means to process an application. As Applicants discuss in the Field of the Invention section of their specification, the application process can include capturing and processing data from applications, transmitting and routing the data, universally validating the data, providing screening and profiling of applicants, making credit decisions, and providing product or service fulfillment (i.e., provide the product or service for which the applicant has applied). Second is asked how to distinguish application processing performed by a worker utility and application processing performed by the handler system. As discussed above, in claim 1 only the worker utilities process an application. A handler system invokes the plurality of worker utilities, which in turn process the application. A handler system

does not itself process the application. Thus, to speak of processing by the handler system is to misconstrue the plain language used to described the handler system.

The reasoning set forth above applies equally to independent claims 10 and 12. Therefore, Applicants submit that these claims also conform to the requirements of § 112, second paragraph. Moreover, the other claims rejected under this section dependent from one or another of the independent claims and, therefore, also are submitted to be in conformance.

This Amendment After Final Action is believed clearly to place the present application in condition for allowance. In particular, no further search is necessary as there is no outstanding art rejection, and the amendments made require only cursory consideration. Therefore, entry of this Amendment under 37 C.F.R. § 1.116 is believed proper and is respectfully requested, as an earnest effort to advance prosecution and reduce the number of issues. Should the Examiner believe that issues remain outstanding, it is respectfully requested that the Examiner contact Applicants' undersigned attorney in an effort to resolve such issues and advance the case to issue.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

No petition to extend the time for response to the Office Action is deemed necessary for this Amendment. If, however, such a petition is required to make this Amendment timely filed, then this paper should be considered such a petition and the Commissioner is authorized to charge the requisite petition fee to Deposit Account 50-3939.

Applicants' undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

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